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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,552	09/18/2003	Bert W. Elliott	25244A	4288
22889	7590	07/22/2008		
OWENS CORNING 2790 COLUMBUS ROAD GRANVILLE, OH 43023				
			EXAMINER CHAPMAN, JEANETTE E	
			ART UNIT	PAPER NUMBER
			3633	
			MAIL DATE	DELIVERY MODE
			07/22/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/664,552

**Applicant(s)**

ELLIOTT ET AL.

**Examiner**

Chapman E Jeanette

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5,13,14,21,28-30 and 32-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-15,21,28-30 and 32-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 13-14, 21, 28-30, 32-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daimond (4148168) in view of King et al (6220329) and Steiner, Jr. et al (6174403). Daimond discloses a method of covering a roof deck comprising:

- Laying a plurality of successive horizontal courses of covering shingles above a starter shingles laid in a side-by-side relationship at an eave edge of a roof deck; see figure 4A;
- The covering shingles laid in a side-by-side relationship and horizontally offset from the covering shingles in adjacent courses;
- Each covering shingle includes a headlap portion and a butt portion;
- The butt portion includes a plurality of tabs 22 separated by cutouts 14A;
- Daimond shows a difference in height between the covering and starter shingle; the exact difference has been considered a matter of choice; one of ordinary skill in the art would have appreciated any height difference which would provide for the intended purpose and function of the method
- The butt portions of the starter shingles have an overall color appearance that is similar to an overall color appearance of the covering shingles

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Diamond lacks the starter shingle of the course of starter shingles is a laminated starter shingles comprising an underlay and overlay sheet. Diamond also lacks the starter shingle including an exposed portion extending between tabs of the covering shingles.

Steiner et al discloses laminated shingle layers of various heights; hence one layer can be greater than another; the amount or exact measurement of difference has been considered a matter of choice. One of ordinary skill in the art would have appreciated that change in height causes variations in appearance. See column 2, line 63 through column 3, line 15.

King et al discloses the starter shingle 126 and the course shingles 122 and 124. King also discloses the starter shingle including an exposed portion extending between tabs of the covering shingles. See figures 6-7. Again, the covering shingle is a laminated covering shingle with a overlay member having a headlap and a butt portion; the underlay member is attached to the rear surface of the butt portion of the overlay member because the underlay member and the overlay member define a laminated covering shingle. The butt portion includes a plurality of tabs separated by cutouts and the cutouts extending through the laminated covering shingle wherein the exposed portion of the starter shingle extends between the tabs of the covering shingles. See figures 6-7. King also discloses the butt portion including a butt edge and the underlay sheer includes a lower edge. The lower edge and the butt edge are vertically aligned to define a lower edge. The lower edge of the covering shingles in the first course is

vertically aligned with the lower edge of the starter shingles. See figure 10b, 1 lb and 6-7.

King et al discloses applying a bead of adhesive to a bottom surface of the underlay sheet; see figures 10b and 1 lb.

In view of the above, it would have been obvious to modify Daimond to include a laminated starter strip and to include the exposed portion of the shingle to strengthen the shingle structure and to provide a more decorative appearance to the shingle structure when applied to any substrate. It would have also been obvious to make the laminate layers of different heights to effect a different and enhanced appearance as taught by Steiner, Jr. et al.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-40 have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's argument that the combination of the above three references do not meet the structure of the invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Further, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections

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are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The king reference discloses a starter shingle in that the same lies beneath other shingles and is a beginning to the course of laid shingles. King shows the same as a starter shingle and hence the same can be used as starter shingles; the issue is not how well the same functions but what is shown by the prior art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chapman E. Jeanette whose telephone number is 571-272-6841. The examiner can normally be reached on Mon.-thursday, 8:30-6:00, every fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAKO SLACK can be reached on 571-272-6848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
JEANETTE CHAPMAN  
PRIMARY EXAMINER  
ART UNIT 3635

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